

M&G 30435.45USU1

MERCHANT, GOULD, SMITH, EDELL, WELTER & SCHMIDT

United States Patent Application

DECLARATION UNDER 37 C.F.R. § 1.63

As a below named inventor I hereby declare that: my residence, post office address and citizenship are as stated below next to my name; that

I verily believe I am the original, first and sole inventor (if only one name is listed below) or a joint inventor (if plural inventors are named below) of the subject matter which is claimed and for which a patent is sought on the invention entitled: SECRETORY IMMUNOGLOBULIN PRODUCED BY SINGLE CELLS AND METHODS FOR MAKING AND USING SAME

The specification of which

a. ☒ is attached hereto

b. ☐ was filed on _____ as application serial no. _____ and was amended on _____ (if applicable) (in the case of a PCT-filed application) described and claimed in international no. _____ filed _____ and as amended on _____ (if any), which I have reviewed and for which I solicit a United States patent.

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the patentability of this application in accordance with Title 37, Code of Federal Regulations, § 1.56 (attached hereto).

I hereby claim foreign priority benefits under Title 35, United States Code, § 119/365 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on the basis of which priority is claimed:

a. ☒ no such applications have been filed.

b. ☐ such applications have been filed as follows:

FOREIGN APPLICATION(S), IF ANY, CLAIMING PRIORITY UNDER 35 USC § 119			
COUNTRY	APPLICATION NUMBER	DATE OF FILING (day, month, year)	DATE OF ISSUE (day, month, year)
ALL FOREIGN APPLICATION(S), IF ANY, FILED BEFORE THE PRIORITY APPLICATION(S)			
COUNTRY	APPLICATION NUMBER	DATE OF FILING (day, month, year)	DATE OF ISSUE (day, month, year)

I hereby claim the benefit under Title 35, United States Code, § 120/365 of any United States and PCT international application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, § 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, § 1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application.

U.S. APPLICATION NUMBER	DATE OF FILING (day, month, year)	STATUS (patented, pending, abandoned)

I hereby claim the benefit under Title 35, United States Code § 119(e) of any United States provisional application(s) listed below:

U.S. PROVISIONAL APPLICATION NUMBER	DATE OF FILING (Day, Month, Year)
60/040,944	12-05-97

I hereby authorize them to act and rely on instructions from and communicate directly with the person/assignee/attorney/firm/ organization who/which first sends/sent this case to them and by whom/which I hereby declare that I have consented after full disclosure to be represented unless/until I instruct Merchant, Gould, Smith, Edell, Welter & Schmidt to the contrary.

Please direct all correspondence in this case to Merchant, Gould, Smith, Edell, Welter & Schmidt at the address indicated below:

Merchant, Gould, Smith, Edell,
Welter & Schmidt
Westwood Gateway II, Suite 400
11150 Santa Monica Blvd.
Los Angeles, CA 90025-3395

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2	Full Name Of Inventor	Family Name Morrison	First Given Name Sherie	Second Given Name L.
0	Residence & Citizenship	City Los Angeles	State or Foreign Country California	Country of Citizenship U.S.A.
1	Post Office Address	Post Office Address 258 Denslow Avenue	City Los Angeles	State & Zip Code/Country California 90049
Signature of Inventor 201:			Date: June 9, 1998	
2	Full Name Of Inventor	Family Name Chintalacharuvu	First Given Name Kote	Second Given Name R.
0	Residence & Citizenship	City Los Angeles	State or Foreign Country California	Country of Citizenship USA India 06/98
2	Post Office Address	Post Office Address 3241 S. Sepulveda Boulevard, Apt. 202	City Los Angeles	State & Zip Code/Country California 90034
Signature of Inventor 202:			Date: June 9, 1998	
2	Full Name Of Inventor	Family Name	First Given Name	Second Given Name
0	Residence & Citizenship	City	State or Foreign Country	Country of Citizenship
3	Post Office Address	Post Office Address	City	State & Zip Code/Country
Signature of Inventor 203:			Date:	
2	Full Name Of Inventor	Family Name	First Given Name	Second Given Name
0	Residence & Citizenship	City	State or Foreign Country	Country of Citizenship
4	Post Office Address	Post Office Address	City	State & Zip Code/Country
Signature of Inventor 204:			Date:	

2	Full Name Of Inventor	Family Name	First Given Name	Second Given Name
0	Residence & Citizenship	City	State or Foreign Country	Country of Citizenship
5	Post Office Address	Post Office Address	City	State & Zip Code/Country
Signature of Inventor 205:			Date:	

§ 1.56 Duty to disclose information material to patentability.

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is canceled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is canceled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through had faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) prior art cited in search reports of a foreign patent office in a counterpart application, and
- (2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

- (1) It establishes, by itself or in combination with other information, a *prima facie* case of unpatentability of a claim;
- (2) It refutes, or is inconsistent with, a position the applicant takes in:
 - (i) Opposing an argument of unpatentability relied on by the Office, or
 - (ii) Asserting an argument of patentability.

A *prima facie* case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (1) Each inventor named in the application;
 - (2) Each attorney or agent who prepares or prosecutes the application; and
 - (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.
- (d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

Attorney Docket No.: 30435.45USU1

Applicant: Sherie L. Morrison and Kote R. Chintalacheruvu
Serial No.: Not yet assigned
Filed: Herewith
For: SECRETORY IMMUNOGLOBULIN PRODUCED BY SINGLE CELLS AND
METHODS FOR MAKING AND USING SAME
Group: Not yet assigned
Examiner: Not yet assigned

**POWER OF ATTORNEY BY ASSIGNEE
AND EXCLUSION OF INVENTOR(S) UNDER 37 C.F.R. 3.71**

Dear Sir:

The undersigned assignee of the entire interest in the above-identified subject application hereby appoints

Albrecht, John W.	Reg. No. 40,441	Lasky, Michael B.	Reg. No. 29,335
Ansema, Gregory M.	Reg. No. P-42,264	Lindquist, Timothy A.	Reg. No. 40,701
Bazell, Brian H.	Reg. No. 32,860	Lynch, David W.	Reg. No. 36,204
Beard, John L.	Reg. No. 27,612	Mau, Michael L.	Reg. No. 30,087
Berman, Charles	Reg. No. 20,240	Matsu, Leroy D.	Reg. No. 35,274
Black, Bruce E.	Reg. No. P-41,622	McDaniel, Karen D.	Reg. No. 37,674
Bogucki, Raymond A.	Reg. No. 17,426	McDonald, Daniel W.	Reg. No. 32,044
Bruess, Steven C.	Reg. No. 34,130	Melnyre, Iain A.	Reg. No. 40,377
Dyrus, Linda M.	Reg. No. 32,404	Mueller, Douglas P.	Reg. No. 30,900
Canady, Karen S.	Reg. No. 39,927	Naslednik, Tyler L.	Reg. No. 40,099
Carlson, Alan G.	Reg. No. 23,989	Nelson, Albin J.	Reg. No. 28,690
Carter, Charles G.	Reg. No. 33,083	Orier, Anthony J.	Reg. No. 41,232
Casper, Philip P.	Reg. No. 33,227	Pasty, Daniel M.	Reg. No. 40,123
Chispetta, James R.	Reg. No. 39,634	Plunkett, Theodore	Reg. No. 37,209
Clifford, John A.	Reg. No. 30,347	Pysal, Melissa J.	Reg. No. P-41,512
Cooper, Victor G.	Reg. No. 39,641	Roth, John C.	Reg. No. 37,703
Crawford, Robert	Reg. No. 32,122	Railand, Earl D.	Reg. No. 25,767
Daignault, Ronald A.	Reg. No. 25,968	Rittmaster, Ted R.	Reg. No. 32,933
Deley, Dennis R.	Reg. No. 34,994	Schmalz, David G.	Reg. No. 39,828
Dalginth, Leslie E.	Reg. No. 40,579	Schmidt, Cecil C.	Reg. No. 20,566
Deulien, Julie R.	Reg. No. 36,414	Schussan, Mark D.	Reg. No. 31,197
DeVries Smith, Kate	Reg. No. P-42,157	Schumann, Michael D.	Reg. No. 30,472
DiPietro, Mark J.	Reg. No. 28,707	Sebald, Gregory A.	Reg. No. 35,280
Edell, Robert T.	Reg. No. 20,187	Sharp, James A.	Reg. No. 34,951
Epp Ryan, Sandra	Reg. No. 39,667	Sheng, Mark T.	Reg. No. 40,178
Farber, Michael B.	Reg. No. 32,612	Smith, Jerome E.	Reg. No. 35,684
Funk, Steven R.	Reg. No. 37,830	Soderberg, Richard	Reg. No. P-43,392
Glanco, Robert J.	Reg. No. 40,620	Sammar, John P.	Reg. No. 29,114
Golin, Charles E.	Reg. No. 26,896	Samner, John S.	Reg. No. 34,216
Gorman, Alan G.	Reg. No. 38,472	Tullikson, David K.	Reg. No. 32,314
Gould, John D.	Reg. No. 18,223	Trembath, Jon R.	Reg. No. 38,344
Gregson, Richard	Reg. No. P-41,804	Underhill, Albert L.	Reg. No. 27,403
Gross, John J.	Reg. No. 33,112	Vandenburgh, J. Darrk	Reg. No. 32,179
Hamm, Curtis B.	Reg. No. 29,163	Vicior, David W.	Reg. No. 38,867
Hillson, Randall A.	Reg. No. 31,838	Wetter, Paul A.	Reg. No. 20,890
Johnston, Scott W.	Reg. No. 39,721	Whippe, Brian	Reg. No. P-43,261
Kastello, Joseph M.	Reg. No. 37,160	Williams, Douglas J.	Reg. No. 27,854
Katzberger, Denise	Reg. No. 33,924	Witz McDonald, Joseph	Reg. No. P-41,980
Komanderi, Janaki	Reg. No. 40,684	Wood, Gregory B.	Reg. No. 28,133
Kowalchuk, Alka W.	Reg. No. 31,535	Wood, William J.	Reg. No. P-42,236
Kowalchuk, Katherine M.	Reg. No. 36,848	Xu, Min S.	Reg. No. 39,536
Lacy, Paul E.	Reg. No. 38,946		
Larson, James A.	Reg. No. 40,443		

PATENT

as its attorney to prosecute this application and to transact all business in the United States Patent and Trademark Office connected therewith, said appointment to be to the exclusion of the inventors and their attorney(s) in accordance with the provisions of 37 C.F.R. 3.71.

An assignment of the entire interest in the above-identified subject application:

- ☐ was recorded on _____ at reel/frame _____ / _____.
- ☒ is submitted herewith for recording.

Please direct all telephone calls to Karen S. Canady at (310) 445-1140 and all correspondence relative to said application to the following address:

Merchant, Gould, Smith, Edell,
Wahner & Schmidt
Westwood Gateway II, Suite 400
11150 Santa Monica Blvd.
Los Angeles, CA 90025-3395

Dated: 6-2-88

ASSIGNEE: THE REGENTS OF THE UNIVERSITY OF CALIFORNIA

Signature: 

Typed Name: Emily Waldron

Title: Technology Transfer Officer

University of California
405 Hilgard Avenue
Los Angeles, California 90095-1406

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Applicant or Patentee: Sherie L. Morrison and Kote R. Chintalacharvva

Serial or Patent No.: Not yet assigned

Piled or Issued: Herewith

For: SECRETORY IMMUNOGLOBULIN PRODUCED BY SINGLE CELLS AND METHODS FOR MAKING AND USING SAME

UC Case No. LA97-043-02

Docket No. 30435.45USU1

**VERIFIED STATEMENT (DECLARATION) CLAIMING SMALL ENTITY STATUS
(37 C.F.R. 1.9(f) AND 1.27(d)) - NONPROFIT ORGANIZATION**

I hereby declare that I am an official empowered to act on behalf of the nonprofit organization identified below:

NAME OF ORGANIZATION: The Regents of the University of California

ADDRESS OF ORGANIZATION: 1111 Franklin Street, Fifth Floor
Oakland, California 94607-5200

TYPE OF ORGANIZATION

- ☒ UNIVERSITY OR OTHER INSTITUTION OF HIGHER EDUCATION
☐ TAX EXEMPT UNDER INTERNAL REVENUE SERVICE CODE [26 U.S.C. 501(a) and 501(c)(3)]
☐ NONPROFIT SCIENTIFIC OR EDUCATIONAL UNDER STATUTE OF STATE OF THE UNITED STATES OF AMERICA
(NAME OF STATE _____)
(CITATION OF STATUTE _____)
☐ WOULD QUALIFY AS TAX EXEMPT UNDER INTERNAL REVENUE SERVICE CODE [26 USC 501(a) and 501(c)(3)] IF
LOCATED IN THE UNITED STATE OF AMERICA
☐ WOULD QUALIFY AS NONPROFIT SCIENTIFIC OR EDUCATIONAL UNDER STATUTE OF STATE OF THE UNITED
STATES OF AMERICA IF LOCATED IN THE UNITED STATES OF AMERICA
(NAME OF STATE _____)
(CITATION OF STATUTE _____)

I hereby declare that the nonprofit organization identified above qualifies as a nonprofit organization as defined in 13 C.F.R. 1.9(e) for purposes of paying reduced fees under Section 41(a) and (b) of Title 35, United States Code with regard to the invention, entitled SECRETORY IMMUNOGLOBULIN PRODUCED BY SINGLE CELLS AND METHODS FOR MAKING AND USING SAME, by inventors Sherie L. Morrison and Kote R. Chintalacharvva.

- ☒ the specification filed herewith.
☐ application Serial No. _____, filed _____.
☐ Patent No. _____, issued _____.

I hereby declare that rights under contract or law have been conveyed to and remain with the nonprofit organization with regard to the above-identified invention (except for a license to a Federal Agency pursuant to U.S.C. 202 (c) (4)).

If the rights held by the nonprofit organization are not exclusive, each individual, concern or organization having rights to the invention is listed below* and no rights to the invention are held by any person, other than the inventor, who could not qualify as an independent inventor under 37 C.F.R. 1.9(c) if that person made the invention, or by any concern which would not qualify as a small business concern under 37 C.F.R. 1.9(d) or a nonprofit organization under 37 C.F.R. 1.9(e). *NOTE: Separate verified statements are required from each named person, concern or organization having rights to the invention averring to their status as small entities (37 C.F.R. 1.27).

NAME N/A

ADDRESS _____

☐ INDIVIDUAL ☐ SMALL BUSINESS CONCERN ☐ NONPROFIT ORGANIZATION

I acknowledge the duty to file, in this application or patent, notification of any change in status resulting in loss of entitlement to small entity status prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate. (37 C.F.R. 1.28(b))

I hereby declare that all statements made of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under Section 18 USC § 1001, and may jeopardize the validity of the application, any patent issuing thereof, or any patent to which this verified statement is directed.

NAME OF PERSON SIGNING	<u>Emily Waldron</u>
TITLE OF PERSON SIGNING	<u>Technology Transfer Officer</u>
TITLE OF ORGANIZATION	<u>University of California</u>
ADDRESS OF PERSON SIGNING	<u>405 Hilgard Avenue</u> <u>1106 Ueberroth Bldg.</u> <u>Los Angeles, CA 90095-1406</u>

SIGNATURE  DATE 6.9.93

04095385-061098